

REMARKS

Claims 1-13 remain pending in the application.

Allowable Claims 7 and 12

The Applicants thank the Examiner for the indication that claims 7 and 12 are allowed.

Claims 1-5, 8-10 and 13 over Peterzell in view of Lindoff

In the Office Action, claims 1-5, 8-10 and 13 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2003/0040292 to Peterzell et al. ("Peterzell") in view of U.S. Patent No. 6,725,024 to Lindoff et al. ("Lindoff"). The Applicants respectfully traverse the rejection.

Claims 1-3 recite a frequency offset **history** table adapted to contain a plurality of entries each corresponding to a **past** frequency offset of a **device in a piconet**. Claims 4, 5, 8-10 and 13 recite looking up a **past** frequency offset value of a transmitting **piconet device**.

The Examiner alleges that Peterzell discloses "a frequency offset history table adapted to contain a plurality of entries each corresponding to a past frequency offset of a device in a piconet including said smart compensation wireless piconet device (frequency offset table, TABLE 4, Peterzell, Page 9, Paragraph 0096, lines 1-6)" (Office Action at 2)

The Applicants agree that this is an important feature of the present invention. However, the Examiner's main reference, **Peterzell, is not in-and-of itself prior art**.

In particular, the present application was filed on March 21, 2001, which is before the December 10, 2001 filing date of US Appl. No. 10/020,607, which is the published Peterzell document cited by the Examiner. The cited Peterzell published document NOT being prior art, the rejection on its face cannot stand without Peterzell. It is therefore respectfully requested that the rejection be withdrawn.

With respect to any future rejection somehow based (albeit improperly) on the unpublished provisional application from which the underlying application in the published Peterzell document cited by the Examiner claims priority, the Applicant's provide the following:

In particular, the Applicants make note that Peterzell claims priority from an unpublished US Provisional Appl. No. 60/261,714, which was filed January 12, 2001. Though the Provisional application pre-dates the present application, the provisional application is an UNpublished document, and thus in NOT available as prior art. Moreover, it is well settled law that a provisional application is not an "application for patent" as it does not ripen into a patent, and thus is not includable as prior art under 35 USC 102.

As a patent application on its own right, the Peterzell Applicant enjoys the filing date of the provisional application from which it claims priority to the extent that the provisional supports the *claims* of the Peterzell application. But the *claims* of Peterzell are not at issue here. It is respectfully submitted that use of the provisional application filing date as the defacto PUBLICATION date of the LATER-published patent application would be improper.

For the sake of argument, presuming the possibility for an aggressive stance that somehow purports that the Unpublished provisional application is a publication, such disclosure would at best be 'filtered' through the Peterzell patent application that claims priority therefrom. In other words, it would be the Peterzell patent application that would purportedly enjoy the filing date of the provisional application—but only to the extent that the disclosure in the published document is disclosed in the provisional application from which it claims.

In such case, one would have to presume that the published Peterzell application contains the full teachings of the provisional from which the underlying application claims priority. But, it does not.

The provisional not only doesn't disclose much of the later-filed Peterzell, it even more importantly doesn't include the specific disclosure cited by the Examiner in this particular rejection. For instance, to allegedly teach a very

important aspect of the present invention—use of a frequency offset history table containing entries corresponding to past frequency offsets of a particular device in a piconet—the Examiner cites “frequency offset table, TABLE 4, Peterzell, Page 9, Paragraph 0096, lines 1-6). But this cited passage does not even exist in the provisional application. The NON-EXISTENT cited passage in Peterzell, which is NOT prior art, reads:

[0096] In another embodiment (not shown), system 602 may generate a transmit LO frequency by mixing the receive LO frequency for a receiver with a fixed offset LO frequency. This approach recognizes that the following modulation standards have a fixed frequency offset between TX and RX channels, as shown in Table 4.

This disclosure, quite simply, is not present in the provisional application.

Accordingly, for at least all the above reasons, claims 1-5, 8-10 and 13 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



William H. Bollman
Reg. No.: 36,457
Tel. (202) 261-1020
Fax. (202) 887-0336

MANELLI DENISON & SELTER PLLC

2000 M Street, NW 7TH Floor
Washington, DC 20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336